



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/804,293 | 03/13/2001 | Tadahiro Nakao | KPC-289 | 9278 |

7590

11/20/2002

RADER, FISHMAN & GRAUER, P.L.L.C.
1233 20th Street, NW, Suite 501
Washington, DC 20036

EXAMINER

SELLERS, ROBERT E

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 11/20/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

7C-9

Office Action Summary

Application No.

09/804,293

Applicant(s)

NAKAO ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 10-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

The substitute specification filed August 13, 2001 (Paper No. 8) has not been entered because of the presence of new matter. According to MPEP § 608.01(q): "If, however, an examiner becomes aware that new matter is present, objection thereto should be made" in accordance with MPEP § 608.04.

The substitute specification is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material is not supported by either the original specification or the English translation of Japanese priority application nos. 2000-069881 and 2000-075653.

The following newly added material is not supported based on the unmarked substitute specification:

1) Production Examples 5-8, 10 and 11 on page 19, line 20 to page 22, line 24, and page 24, line 5 to page 24, line 3 are not shown on page 16 of application no. 2000-069881 or page 23, Example 7 to pages 24, Example 8; or pages 17-19, paragraphs 39 and 40 of application no. 2000-075653 (Example 1 supports Production Example 9) due to the different reaction conditions and steps.

2) Examples 5-12 and Comparative Examples 2 and 3 on page 29 to 34 and in Table 2 on page 30 are not exhibited anywhere in application no. 2000-069881 or on pages 26-30 of application no. 2000-075653. Table 3 on page 31 appears to correspond to Table 1 on page 30 of application no. 2000-075653. The results of Examples 5-12 and Comparative Examples 2 and 3 in Table 3 mimic Examples 1-8 and Comparative Examples 1 and 3 of Table 1.

Art Unit: 1712

However, Example 5 on page 29 is not equivalent to Example 1 on page 16 of application no. 2000-07563 since Example 5 employs urethane-modified vinyl resin solution (A-5) prepared in Production Example 5 (page 19, line 21 to page 20, line 18) while Example 1 of the priority application utilizes a diverse urethane-modified vinyl resin solution (1) (page 12, paragraph 29 to page 14, line 2 and page 21, Table 1, Example 1).

Applicant is required to cancel the new matter in the reply to this Office Action.

The following restriction and election of species requirement is based on new claims 10-20 (renumbered from claims 1-11 under 37 CFR 1.126 since the original claims are numbered 1-9) presented in the preliminary amendment filed August 13, 2001 (Paper No. 7).

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 10-15, drawn to a composition comprising a urethane-modified vinyl resin, classified in class 525, subclass 327.3.
- II. Claims 16-20, drawn to a composition comprising a urethane-modified vinyl resin and a polymer dispersion, classified in class 525, subclass 208.

Art Unit: 1712

The inventions are distinct, each from the other because:

Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an adhesive and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Claims 10-20 are generic to a plurality of disclosed patentably distinct species comprising:

Contingent upon the election of Group I,

(A) Urethane-modified vinyl resins such as one selected from Production Examples 1-8 on pages 16-22 of the non-entered substitute specification.

Art Unit: 1712

Contingent upon the election of Group II, (A) hereinabove and
(B) polymer dispersions such as one selected from Production Examples 9
and 10 on pages 22-25.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species,
even though this requirement is traversed.

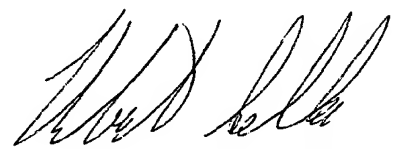
Should applicant traverse on the ground that the species are not patentably
distinct, applicant should submit evidence or identify such evidence now of record
showing the species to be obvious variants or clearly admit on the record that this is the
case. In either instance, if the examiner finds one of the inventions unpatentable over
the prior art, the evidence or admission may be used in a rejection under
35 U.S.C. 103(a) of the other invention.

The reply to this requirement to be complete must include an election of the
invention and species to be examined even though the requirement be traversed
(37 CFR 1.143). Upon the cancellation of claims to a non-elected invention, the
inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the
currently named inventors is no longer an inventor of at least one claim remaining in the
application. Any amendment of inventorship must be accompanied by a request under
37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

(703) 308-2399 (Fax no. (703) 872-9310) Monday to Friday, 9:30 to 6:00

RS

11/19/02



ROBERT E.L. SELLERS
PRIMARY EXAMINER